

**REMARKS**

Claims 1 – 6 have been cancelled. Claims 7 and 8 remain in this Application.

Reconsideration of this Application is requested.

**CLAIM REJECTIONS – 35 USC 102 (b)**

Claims 7 and 8 are rejected under 35 USC 102 (b) as being anticipated under 35 USC 102 (b) by Montesi (US 4,316,290). The Examiner's reasons are as stated in the Communication and will be referred to, where appropriate, herein below.

Applicant's Attorney traverses each and every basis of the Examiner's rejection, based on the Montesi reference, the claim analysis, and case law relied upon. Attention is directed to a Claim chart wherein Applicant's sole independent Claim 7 is distinguished from the Montesi reference.

Applicant's reasons now follow.

**THE PRIOR ART; MONTESI (US-4,316,290):**

The Montesi Patent is directed to an ear muff accessory for a safety hat and illustrates apparatus for mounting a hearing protector on each side of the hat. The apparatus includes a pivot stud 28, retained to a side of the hat, by retainer means 30, and clamping and guide means 40, 50, in the form of a pair of circular wedge shaped stationary inner and outer washers, each washer including at least one inclined surface 44, 54, and each surface being associated with a slot of an adjustable support arm 70.

The support arm 70 is clampingly sandwiched between the inclined surfaces 44 and 54 of the inner and outer washers 40 and 50. The washers are circular and mirror images of one another.

Each washer includes a central aperture, or bore, or hole that extends between its opposite surfaces, to receive a pivot stud 28. The bore forms an opening in the center of each of the upper and lower surfaces of the washer. Further, each washer also includes a boss 46 and 56, the boss being adjacent to the hole that opens on the inclined upper surface 44 and 54 and rising perpendicularly from the inclined face.

In use, the washers 40 and 50 are angularly positioned so that the bosses 46 and 56 are 180° to one another and grip the outer periphery of the pivot stud 28 received in the through bore passing through the center of the washer.

**The Specific Bases of the Anticipation Rejection under 35 USC 102 (b)**

The Examiner rejected Claims 1 and 7 under 35 USC 102 (b) as being clearly anticipated by Montesi (US-4,316,290). The Examiner relies on Montesi as showing a plastic tapered washer (40), of specific diameter (**and thus sized to be attachable to a shoe**) with upper and lower continuous planar surfaces angularly inclined with respect to each other, at a specific angle. The Examiner contends that the upper and lower surfaces are **continuous** since there is **no break in the surfaces**. In support, the Examiner has cited certain case law to support the rejection.

Applicant strongly disagrees with the Examiner's rejection, both as to claim construction and case law, for several reasons, as well be detailed herein below.

Initially, the Examiner finds a wedge-shaped article within the universe of all devices, and then concludes its appropriateness for use in a shoe (without appreciating the solution related to gait improvement). Then, without regard to a boss that protrudes above the inclined surface,

or the opening (i.e., hole) formed in each surface of the washer, considers the surfaces to be continuous since there is no break in the surfaces. The Examiner's anticipation is terribly flawed.

### **DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMS**

Claim 7:	Montesi
a balancing disc for balancing the gait of a user, comprising:	Directed to an ear muff for mounting a hearing protector on a hat
a disc that is wedge shaped and circular	washers 40 and 50 are wedge shaped and circular
the disc has a <u>continuous planar</u> upper surface and a <u>continuous planar</u> lower surface	<p>The washers 40 and 50 have an <u>inclined</u> surface 44 and 54. The inclined surfaces 44 and 54 <u>do not</u> teach the provision of "a continuous planar surface", because:</p> <p><u>The inclined surfaces 44 and 54 are not planar.</u> The term planar may be visualized as a flat infinite piece of paper lying in the same plane, flat. Each inclined surface 44 and 54 includes an upstanding boss and thus the surface is not flat or lying in a <u>single</u> geometric plane.</p> <p><u>The inclined surfaces 44 and 54 are not continuous.</u> To be continuous, the inclined surface 44 and 54 can have no gaps, holes, or breaks in it. Each inclined surface 44 and 54 includes both a central hole or opening, resulting from the through bore or aperture, and an upstanding boss. The <u>central opening</u> of the aperture on the inclined surface is a hole that opens on the surface, and is a <u>break</u> or <u>discontinuity</u> in the inclined surface. The <u>boss</u> is a <u>break</u> or <u>discontinuity</u> in the inclined surface. Thus the inclined surface does not form a <u>continuous</u> surface from one to the other side of the washer circumference; the inclined surface has interruption, break and irregularity.</p> <p><u>The opposite surface of each washer is not continuous.</u> The central aperture through</p>

	each washer forms a hole, which opens on surface (opposite to the surface 44 or 54) and interrupts or breaks any continuity in the (lower) surface.
the upper and lower surfaces are angularly inclined with respect to each other by an angle $\theta$ of about $2^\circ$ to about $6^\circ$	the surfaces are between $5^\circ - 10^\circ$ to one another and preferably about $5^\circ$
the disc must be attachable to a footwear item for imparting proper weight distribution and balance to the user	The wedge shaped washers 40 and 50 are not used, or intended to be used, teach or suggest a use in balancing a user's gait, but are used as a matched pair (not alone) as guiding and clamping (sandwiching) a support arm 70 between the inclined faces and orienting a pivot stud 28.

As clearly evidenced in the chart, the Examiner's reliance on the clamping washer (40) of Montesi to reject the balancing disc required in Claim 7 is not sustainable. As is clearly seen, the structural and functional limitations of Claim 7 are not found in the washers 40 and 50 of Montesi.

Applicant's Attorney is troubled with the following conclusion of the Examiner:

"the upper and lower surfaces are considered continuous since there is no break in the surfaces".

Applicant cannot understand how a hole in the center of each upper and lower surface of the washer does not constitute a break in the continuity of the surface and submits that the Examiner is completely wrong in this regard. Montesi does not respond to applicant's claims.

Furthermore, there is no basis for the Examiner's gratuitous conclusion that one could use just the washer 40 in a shoe. The Examiner ignores the washer 40 being just one of a pair of clamping washers 40 and 50, which are used together, and ignores the required upstanding boss.

If the washer 40 replaces the orthotic disc, as claimed, and is placed in a shoe, the boss would ruin the orthotic disc for the purpose intended.

Even if the washer 40 were to be used in a shoe, and the Montesi reference makes no hint or suggestion for such use, the washer still does not meet the limitations required by Claim 7.

Montesi is non-analogous art, and the reference should be withdrawn.

The Examiner explains the propriety of relying on non-analogous art as follows:

“[the reference must be] **reasonably pertinent** to the **particular problem** with which the applicant was concerned, in order to be relied upon as a basis for the rejection of the claimed invention. (citing *In re Oetiker*).

(Emphasis supplied herein)

Applicant is concerned with the problem of balancing gait. Applicant’s problem was not in any way directed to finding a clamping solution, such as by sandwiching something between two like shaped washers. Montesi is concerned with clamping, not balancing. The Examiner is requested to point out where the Examiner finds support, in Montesi, wherein “Montesi is **reasonably pertinent** to the **particular problem** with which Applicant was concerned.

Applicant’s Attorney submits that Montesi is irrelevant, certainly not reasonably pertinent, and should be withdrawn, either as irrelevant, non-analogous; or not responding to Applicant’s claim elements.

The Examiner contends that the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable (citing *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)).

As noted above, the Montesi reference is irrelevant. Even assuming that the preamble and or statements of use are to be ignored, the requirements of Claim 7 are not found in exactly the same situation and united in the same way in a single prior art reference.

As stated in MPEP § 2114, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. (Emphasis supplied herein) In *Masham*, the preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the reference was related to mixing.

The MPEP further goes on to state that even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. (Emphasis supplied herein)

The facts of this case render the *Masham* decision as not on point. Montesi does not include each of the limitations required by the claims. The orthotic gait disc, as claimed, is not relevant to clamping structure requiring cooperation between two specially wedges (Montesi). That one of the wedges shows coincidental structure is not sufficient for anticipation.

The Examiner contends that

"[T]he law of anticipation does not requires that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something

**disclosed in the reference**, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed. Cir. 1983) [Emphasis supplied herein]

Applicant disagrees. Even if true, without more, all of the claim elements required herein are not found in Montesi. Restated, using the Examiner's expression, the elements required in Applicant's claims "do not read on something" in the Montesi reference.

Having construed the claim limitations at issue, the claims must be compared to the prior art to determine if the prior art anticipates those claims. Applicant's Attorney disagrees with the manner in which the Examiner has construed the required elements and the application of the law thereto. Problems and solutions in the art of balancing the gait of a person's foot are totally irrelevant to solutions for clamping or otherwise holding an element in position.

Applicant's Attorney believes that the Examiner's contention that anticipation need only **read on something disclosed in a reference** is a stretch.

As to anticipation, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[T]here is no anticipation 'unless all of the same elements are found in exactly the same situation and united in the same way . . . in a single prior art reference.'" *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984)

(citing *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983).

In other words, anticipation under §102(a) requires that the identical invention that is claimed was previously known to others and thus is not new. *Continental Can Co. USA, Inc., v. Monsanto Co.*, 948 F.2d 1264, 1267 (Fed. Cir. 1991) (citations omitted). More specifically, the Examiner must show that each element of the claim is found in the Montesi Patent. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). The Montesi reference is deficient.

A corollary to this single reference rule is that absence from the reference of any claimed element negates anticipation. *Atlas Power Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1573-74 (Fed. Cir. 1984). As such, because Montesi lacks certain required elements, Montesi cannot be relied on to support anticipation under 35 USC 102 (b).

The Examiner further contends that it is only necessary that a reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. (citing *In re Mott*). (Emphasis supplied herein). The Examiner then concludes that all of the **claimed** structural elements are clearly anticipated by Montesi. (Emphasis in original) Applicant's Attorney disagrees.

The Examiner is using an "obvious-type" rejection (35 USC 103) to form an anticipation rejection (35 USC 102). As noted, Montesi has no identity of elements. In order to make the washer (40) capable of responding, structurally and functionally, to the disc required by the claims, the Examiner redesigns the washer, where needed, to produce the disc required by the claim.



All of the claimed structural elements are not anticipated by Montesi.

Further, Montesi does not suggest the Examiner's redesign, in as complete a detail as required by Applicant's claims, primarily because there is no motivation for the reconstruction of a clamping washer (one of a matched pair, which perform a clamping function) to function as a gait disc.

One skilled in the art of providing solutions to walking, i.e., gait, would not have looked for solutions thereto in the head gear art, or in positioning an ear muff about a person's ear, or in clamping, generally.

Applicant's claims, whether the redesign be structural (as required by the literal claim language) or functional (the intended use), are not shown or suggested in Montesi. Certainly, the Montesi washer, as disclosed in the reference, is not capable of meeting the structural or functional limitations of Applicant's claims. Such "capable of redesign" is not a proper anticipation rejection under 35 USC 102 but an obviousness type rejection under 35 USC 103.

**CONCLUSION**


Applicant's Attorney submits that the Examiner's rejection of Claims 7 and 8, under 35 USC 102 (b), as being anticipated by Montesi, is overcome and should be withdrawn.

Applicant's Attorney submits that Claims 7 and 8, all claims pending herein, define patentably over the prior art and are in condition for allowance.

A Notice of allowance is respectfully requested.

If the Examiner feels that the prosecution of this application can be expedited then she is courteously requested to place a telephone call to applicant's attorney at the number listed below.

Respectfully Submitted,



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